

REMARKS

Claims 110 and 111 have been amended. Claims 1-111 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 101 Rejection:

The Office Action rejected claims 110 and 111 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 110 and 111 have been amended to recite a tangible, computer-accessible medium configured to store program instructions. Accordingly, withdrawal of the section 101 rejection is respectfully requested.

Section 103(a) Rejections:

The Office Action rejected claims 1-5, 8-16 and 18-24 under 35 U.S.C. § 103(a) as being unpatentable over Teodosiu et al. (U.S. Publication 2002/0062375) (hereinafter “Teodosiu”) in view of Borella et al (U.S. Patent 6,269,099) (hereinafter “Borella”), claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Teodosiu and Borella and further in view of Rochberger et al. (U.S. Patent 6,456,600) (hereinafter “Rochberger”), and claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Teodosiu and Borella and further in view of Microsoft Dictionary 4th Edition (hereinafter “Microsoft”). The Office Action rejected claims 25-38 based on the same rationale as claims 1-24, claims 39-49 based on the same rationale as claims 1-24, claims 50-56 based on the same rationale as claims 1-18, claims 57-78 based on the same rationale as claims 1-24, claims 79-93 based on the same rationale as claims 1-24, claims 94-99 based on the same rationale as claims 1-24, claims 100-109 based on the same rationale as claims 1-24, and claims 110-111 based on the same rationale as claims 1-24. Applicants respectfully traverse these rejections for at least the following reasons.

The rejection is improper because Teodosiu does not qualify as a prior art reference. More specifically, Teodosiu is a published U.S. patent application that was

filed on Sep. 13, 2001, after Applicants' priority date of Jan. 22, 2001. Teodosiu does claim the benefit of two provisional applications both filed Nov. 22, 2000. However, the Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and the provisional application. **A review of Teodosiu's two provisional applications shows that they vary greatly from Teodosiu's published utility application.** The subject matter on which the Examiner is relying on to reject Applicants' claims does not appear to be entirely present in one of Teodosiu's provisional applications. Therefore, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

For example, in the rejection of claims 1-5, 8-16 and 18-24, the Examiner relies on the following paragraphs and figures of Teodosiu: [0008], [0010], [0029], [0031], [0032], [0038-0040], [0044 - 0057], [0072 - 0077] and FIG. 3. None of these paragraphs are found in either of Teodosiu's provisional applications, and FIG. 3 of Teodosiu is drawn and labeled differently in provisional application 60/252,658. The Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and a single one of the provisional applications. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981). **Since the portions of Teodosiu relied upon by the Examiner to reject the claims are not common to both Teodosiu's published application and one of Teodosiu's provisional applications, the rejection is improper.**

Moreover, Teodosiu's published application is not entitled to the Nov. 22, 2000 date as a section 103(a) prior art date unless at least one claim of Teodosiu's published application is supported (under 35 U.S.C. § 112) in a single one of the provisional applications. Under 35 U.S.C. 119(e)(1), a published utility application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. Since both of Teodosiu's provisional applications are much shorter informal papers as compared to Teodosiu's utility application, it is not at all clear that either one of Teodosiu's provisional applications alone provide full 35 U.S.C. § 112

support for any of the claims of Teodosiu's published utility application. The rejection is further improper unless the Examiner can show that Teodosiu's published application has the necessary claim support in a single one of the provisional applications to be entitled to the provisional application's filing date as its § 103(a) prior art date. *See also* M.P.E.P. § 2136.03(IV).

The Office has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). **Since the Examiner has not proven that both of the above requirements have been met for Teodosiu's teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.**

The Applicants also assert that the claims include numerous distinctions over the cited art. However, since the rejections are based on a reference that does not qualify as prior art, no further arguments are required at this time.

CONCLUSION


Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-06900/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☒ Other: *Information Disclosure Statement*

Respectfully submitted,



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